

REMARKS

This Amendment is submitted in response to the Office Action dated December 14, 2004. In the Office Action, the Patent Office rejected Claims 1, 2, 4-7, 15 and 18-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,793,972 to *Shane* in view of U.S. Patent No. 6,738,754 to *Norman, Jr.* Additionally, the Patent Office rejected Claims 3, 8-14, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Shane* in view of *Norman, Jr.* and further in view of U.S. Patent No. 6,195,651 to *Handel et al.*

By the present Amendment, Applicant amended Claims 1, 3, 5, 10 and 15 and submits that the amendment to the claims and the remarks below overcome the rejections by the Patent Office for the reasons that follow.

With respect to the rejection of Claims 1, 2, 4-7, 15 and 18-21 under 35 U.S.C. §103(a) as being unpatentable over *Shane* in view of *Norman, Jr.*, Applicant submits that this rejection has been overcome in view of the claims, as amended, and for the reasons that follow.

In the Office Action, the Patent Office alleged:

With respect to Claim 1, *Shane* teaches providing a remote server having a database (a remote computer having database: col. 4, lines 20-48);

creating a website having a first web page by the remote computer on the remote server (creating web page: col. 3, lines 5-10);

Shane does not clearly teach predefined information and predefined attributes wherein the predefined attributes are characteristics of the plurality of healthcare providers and linking the website to the

database wherein the database is searchable via a search engine wherein the search engine searches the database for specific attributes wherein one of the specific attributes corresponds to one of the pre-defined attributes.

However, *Norman, Jr.* teaches a plurality of healthcare providers having the owner of the Internet web site consisting the information related to healthcare providers such as health information stored in the database (col. 5, lines 27-64) by placing on the prescription sheet keywords (col. 6, lines 61-67), the user retrieves healthcare information via the Internet web site (col. 2, lines 8-20) and using a database search engine (col. 3, lines 40-45).

Independent Claim 1, as amended, requires a method having the step of editing a presentation of the website wherein one of the plurality of healthcare providers selects a preference from the remote server via the first remote computer wherein the presentation of the website is based on the preference and further wherein the preference relates to one of a style of the website, a text of the website or a graphic of the website. Moreover, Claim 1 requires the step of designing the first web page of the website wherein the pre-defined information and one of the pre-defined attributes on the first web page of the website are arranged on the first web page by one of the plurality of healthcare providers via the first remote computer.

Additionally, in the Office Action, the Patent Office alleged:

With respect to Claim 15, *Shane* teaches a remote server having a database therein wherein the database is accessible by a computer network (a remote computer having database: col. 4, lines 20-48);

Shane does not clearly teach using predefined information contained on the remote server wherein the predefined information corresponds to one of a plurality

of healthcare providers.

However, Norman teaches a plurality of healthcare providers having the owner of the Internet web site consisting the information related to healthcare providers such as health information stored in the database (col. 5, lines 27-64) by placing on the prescription sheet keywords (col. 6, lines 61-67).

Independent Claim 15, as amended, requires pre-defined information describes amenities of one of the healthcare providers and identifies a location of one of the healthcare providers wherein the web page is created with the pre-defined information and further wherein the website is stored on the database. Further, claim 15 requires a list of design choices in the database wherein one of the healthcare providers selects a design choice from the list of design choices wherein the design choice effects a presentation of the web page of the website and further wherein the design choice relates to one of a style of the web page, a text, a graphic, a photograph or a link from the website. Moreover, Claim 15 requires a list of pre-defined attributes in the database wherein one of the pre-defined attributes is selected from the list of pre-defined attributes wherein the pre-defined attributes identify healthcare services of the healthcare providers wherein one of the healthcare providers arranges the pre-defined information and one of the pre-defined attributes on the web page of the website via the remote computer.

Shane merely teaches a system for providing an interactive response to direct marketing programs, which involve the creation

of a personalized computer web page or like computer user interface accessible by each recipient of the direct mail. *Norman, Jr.* merely teaches a method of directing a patient to a source of health care information. The method has a steps of placing on a prescription sheet an address for the Internet website and identifying an ailment of the patient and ascertaining a code associated with the ailment.

Clearly, neither *Shane* nor *Norman, Jr.*, taken singly or in combination, teaches or suggests the step of editing a presentation of the website wherein one of the plurality of healthcare providers selects a preference from the remote server via the first remote computer wherein the presentation of the website is based on the preference and further wherein the preference relates to one of a style of the website, a text of the website or a graphic of the website as required by Claim 1. Further, neither *Shane* nor *Norman, Jr.*, taken singly or in combination, teaches or suggests the step of designing the first web page of the website wherein the pre-defined information and one of the pre-defined attributes on the first web page of the website are arranged on the first web page by one of the plurality of healthcare providers via the first remote computer as required by Claim 1. On the contrary, *Shane* teaches "web page creator 40 will access a pre-developed and stored web page and merge it with data retrieved from the recipient database 12." Further, *Shane* teaches "web page 60 may be similar to a

standard form letter into which certain pieces of data, such as, the responding recipient's name 62." *Norman, Jr.* teaches "the presence of the Internet navigational system 40 allows treating physicians or other health care providers to "prescribe" a visit to an information web site employing the system."

Clearly, neither *Shane* nor *Norman, Jr.*, taken singly or in combination, teaches or suggests pre-defined information describes amenities of one of the healthcare providers and identifies a location of one of the healthcare providers wherein the web page is created with the pre-defined information and further wherein the website is stored on the database as required by Claim 15. Further, neither *Shane* nor *Norman, Jr.*, taken singly or in combination, teaches or suggests a list of design choices in the database wherein one of the healthcare providers selects a design choice from the list of design choices wherein the design choice effects a presentation of the web page of the website and further wherein the design choice relates to one of a style of the web page, a text, a graphic, a photograph or a link from the website as required by Claim 15. Moreover, neither *Shane* nor *Norman, Jr.*, taken singly or in combination, teaches or suggests a list of pre-defined attributes in the database wherein one of the pre-defined attributes is selected from the list of pre-defined attributes wherein the pre-defined attributes identify healthcare services of the healthcare providers wherein one of the healthcare providers

arranges the pre-defined information and one of the pre-defined attributes on the web page of the website via the remote computer as required by Claim 15.

As set forth above, *Shane* merely teaches "web page 60 may be similar to a standard form letter into which certain pieces of data, such as, the responding recipient's name 62." *Norman, Jr.* merely teaches "the presence of the Internet navigational system 40 allows treating physicians or other health care providers to "prescribe" a visit to an information web site employing the system."

Moreover, with respect to the rejection of Claims 1, 2, 4-7, 15 and 18-21 under 35 U.S.C. §103(a), one of ordinary skill in the art would never have been motivated to modify *Shane* with *Norman, Jr.* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references

in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Shane* and *Norman, Jr.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have combined *Shane* and *Norman, Jr.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

Further, Applicant submits that the Patent Office is merely "piece-mealing" references together providing various teachings and limitations of Applicant's method and system to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible.

In view of the foregoing remarks and amendments, Applicant respectfully submits that the rejection of Claims 1, 2, 4-7, 15 and

18-21 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 3, 8-14, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over *Shane* in view of *Norman, Jr.* and further in view of *Handel et al.*, Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claims 1 and 15 and is improper since none of *Shane*, *Norman, Jr.* and/or *Handel et al.*, taken singly or in combination, teach or suggest the critical steps and features defined in independent Claims 1 and 15, respectively, from which Claims 3, 4, 6, 8-14, 16 and 17 depend. Notice to that effect is requested.

Claims 2-14 depend from independent Claim 1; and Claims 16-21 depend from independent Claim 15. These claims are further believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional steps and elements of Applicant's method and system, respectively.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue.

Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

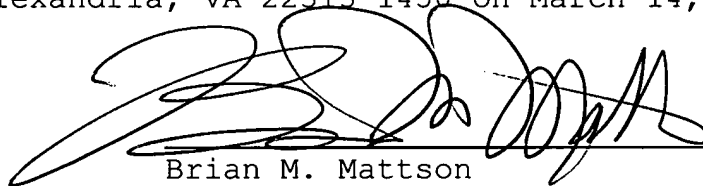


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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 14, 2005.



Brian M. Mattson